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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,289	11/28/2000	David M. Bankers	L294.12-0010	7557

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EXAMINER
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DEMICO, MATTHEW R

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/724,289

Applicant(s)

BANKERS ET AL.

Examiner

Matthew R Demicco

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Figure 1, Element 60. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Claim Objections*

2. Claim 13 is objected to because of the following informalities: the Examiner believes this claim should not depend from Claim 1 but instead from Claim 8. Claim 6 depends from Claim 1 and already recites the limitations of Claim 13. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,611,654 to Shteyn.

Regarding Claim 1, Shteyn discloses a method of guest-selected recording of television programs in an entertainment system (Col. 2, Lines 49-67) having a head end

and a guest terminals connected by a distribution system (See Figure 1). It is inherent that in such a system there may be a plurality of end terminals. Further disclosed is an electronic program guide from which content is selected (Col. 1, Lines 35-39 and Col. 3, Lines 56-58). The provision of such a program guide on user equipment reads on the claimed transmitting a schedule of television programs from the head end to a guest terminal. Further, the user selects a program for recording and later viewing from the program guide. This reads on the claimed transmitting, from the guest terminal to the head end, program recording selection data representing a program selected by a guest for recording. The program is subsequently recorded (Col. 2, Lines 57-67) and streamed from the server to the client for play-out (Col. 4, Lines 15-18). This reads on the claimed creating a digital file representing the program selected, storing the digital file, playing back the program selected based upon the digital file representing the program selected and transmitting the program being played back to the guest terminal. What is not disclosed, however, is transmitting, from the guest terminal to the head end, data requesting playback of the program selected for recording. Official Notice is hereby taken that it is well known the art that a client terminal may make a request for video-on-demand content from a head end server that has recorded such content. Since the system of Shteyn is essentially a customizable video-on-demand delivery system where the user can pre-select items to be recorded, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Shteyn with the client request for video-on-demand content of the well-known prior art in order to

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allow the client to begin playback of the previously recorded content at their convenience.

Regarding Claim 2, Shteyn discloses a method as stated above in Claim 1. Shteyn further discloses the recording of TV broadcasts (Col. 1, Line 66). It is inherent that the server would have a tuner to be able to tune to the channel on which the selected program is carried. Shteyn further discloses storing the file on a server as stated above. The storage of such data on a server reads on the claimed encoding the program into a digital format to create a digital file as is well known in the art.

Regarding Claim 3, Shteyn discloses a method as stated above in Claim 1. Shteyn discloses recording a program at a selected time (Col. 2, Lines 57-59). In order to record a program at a specific time, a recording schedule must be maintained which uses the program recording selection data received.

Regarding Claim 4, Shteyn discloses a method as stated above in Claim 3. Since the data is recorded based on a schedule selected by the user as stated above, it is inherent that the creation of the digital file is based upon the recording schedule.

Regarding Claim 5, Shteyn discloses a method as stated above in Claim 1. It is inherent that the server must have some way of linking the person who requested the recording to the actual recording. This reads on the claimed association between the digital file and the identification of the guest terminal that provided the program recording selection data.

Regarding Claim 6, Shteyn discloses a method wherein the schedule of television programs is an interactive program guide as stated above in Claim 1.

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Regarding Claim 7, Shteyn discloses a method as stated above in Claim 6. Shteyn further discloses that the program recording selection data is produced based upon a selection made on the EPG (Col. 3, Lines 56-57).

Regarding Claim 8, see Claim 1 above. Shteyn further discloses that the client may be a TV tuner (See Figures 1-4) in a hotel (Col. 2, Lines 46-67) and that the server stores and plays out the stored video to the client (Col. 4, Lines 15-18). Since the client is a television receiver in a hotel, this reads on the claimed converting, in response to the playback request data, the digitally stored program to television signals and transmitting the television signals to the guest terminal.

Regarding Claim 9, see Claim 2 above.

Regarding Claim 10, see Claim 5 above.

Regarding Claim 11-12, see Claims 3-4 above.

Regarding Claims 13-14, see Claims 6-7 above.

Regarding Claim 15, Shteyn discloses an entertainment system comprising a plurality of guest terminals, a distribution system connected to the terminals, and a digital content server for storing entertainment content in digital files and supplying to the system television signals based upon the digital files as stated above in Claim 8. Further disclosed is a receiver (See Figures 1-4). In a television receiver as the one disclosed by Shteyn, it is inherent that television programs on a plurality of channels may be received and supplied to the system. Further disclosed is an encoder as stated above for converting the selected television program, which is inherently on one of the channels, to a digital file as stated above. The file is stored on a server as stated above. This reads on the

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claimed transferring the digital file to the digital content server for storage. The server also reads on the claimed computer that communicates with the guest terminals over the distribution system (See Figure 1) and provides them with information about the television programs (EPG as stated above) and controlling operation of the encoder based upon a selection by a guest of a program to be recorded as stated above.

Regarding Claim 16, Shteyn discloses a method as stated above in Claim 15. It is inherent that the recording system would be able to support more than one guest's request at a time. This reads on the claimed encoder being an array including a plurality of tuners for tuning to the channels and an encoding device connected to each tuner.

Regarding Claims 17-18, see Claims 6-7 above.

Regarding Claim 19, Shteyn discloses a method as stated above in Claim 15. Shteyn further discloses a system that in response to a request from a guest terminal, the computer causes the digital content server to supply television signals based upon the digital file representing the selected program as stated above in Claim 8.

Regarding Claim 20, see Claim 3 above.

Regarding Claim 21, Shteyn discloses a method of providing guest-selected viewing of time-shifted television programs in an entertainment system as stated above. What is not disclosed, however, is transmitting from the head end to the guest terminal an interactive display of time-shifted television programs available for viewing based upon the digital file stored. Official Notice is hereby taken that it is well-known in the art that a video-on-demand or digital video recording system with an EPG may display a menu of available content for a user to select. Therefore, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to modify the invention of Shteyn with the interactive display of pre-recording programs of the well-known prior art in order to make selection and management of recorded programs easier for users.

Regarding Claim 22, Shteyn discloses a method of providing time-shifted television programs in an entertainment system as stated above. Further, Shteyn in view of the well-known prior art disclose transmitting a schedule of available time-shifted television programming to the guest terminal as stated above in Claim 21.

Regarding Claim 23, see Claim 2 above.

Regarding Claim 24, Shteyn discloses an entertainment system as stated above in Claim 15.

Regarding Claim 25, see Claim 16 above.

Regarding Claim 26, see Claim 19 above.

Regarding Claim 27, Shteyn discloses a method as stated above in Claim 24. In this system, the computer receives a request for recording and builds a schedule as stated above. Since the computer also handles the recording and subsequently the encoding of the data, this reads on the claimed computer creating a recording schedule for the encoder.

Regarding Claim 28, Shteyn discloses a method of providing guest-selected viewing of time-shifted television programs as stated above.

Regarding Claim 29, Shteyn discloses a method of providing guest-selected viewing of time-shifted television programs as stated above. Shteyn further discloses that the system is operable to record TV broadcasts as stated above. It is inherent that TV

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Art Unit: 2611

broadcasts may include motion pictures and other television programs. This reads on the claimed digital files including a first group of files representing motion pictures and a second group of files represented recorded television programs available for time-shifted viewings.

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent No. 6,163,795 to Kikinis discloses a server that records video segments and, based on user-specified interest, alerts and transmits stored digital video entries on-demand.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R Demicco whose telephone number is (703) 305-8155. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*mrd*

mrd  
February 26, 2004

*Hai Tran*  
HAI TRAN  
PATENT EXAMINER